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EXAMINER

RIES, LAURIE ANNE

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/683,238
Filing Date: December 05, 2001
Appellant(s): SHANAHAN ET AL.

MAILED

DEC 12 2007

Technology Center 2100

Thomas Zell,
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 September 2007 and 23 October 2007
appealing from the Office action mailed 21 February 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,122,647	HOROWITZ	9-2000
6,236,987 B1	HOROWITZ	5-2001
5,986,651	REBER	11-1999
2002/0032672 A1	KEITH	3-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 9, 11-12, 16-18, and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", and Reber (U.S. Patent 5,986,651).

As per independent claims 1, 11, and 21, Horowitz '647 discloses a system, article of manufacture and method for enriching (or annotating with a predefined theme) the content of a document by enriching at a meta-document server the identified document content using a set of document service requests (See Horowitz '647, Column 10, lines 8-27) and making the enriched document content available at the server (See Horowitz '647, Column 11, lines 39-40).

Horowitz '647 does not disclose expressly a personality identifier associated with a database of personalities defining enrichment themes, where the enriching recognizes and annotates entities in the identified document content related to the enrichment theme of the associated personality, or recording the personality identifier from the identifier tag with a reader.

Horowitz '987 discloses using a topic ID, recorded with a dynamic content organization module, which reads the content (See Horowitz '987, Column 10, lines 41-61) into a database on a computer, and therefore digitally readable, which is associated with a topic, or personality, in a database of topics, or personalities (See Horowitz '987, Column 8, lines 36-67, Column 9, lines 1-5, and Column 10, lines 36-41). Horowitz '987 also discloses a supertopic arrangement containing associated subtopics, which can be used to enrich a document based on the specific supertopic (See Horowitz '987,

Column 11, lines 52-67, and Column 12, lines 1-26), and annotating entities in the identified document content related to the associated supertopic (See Horowitz '987, Column 8, lines 52-67 and Column 9, lines 1-29).

Horowitz '647 also does not disclose assigning different personality identifiers including time information and position information, recorded with an electronic tag reader including a transmitter and receiver to read an electronic identification tag.

Reber discloses a network navigation device from which electronic identification data may be read, which includes a transmitter and receiver (See Reber, Column 4, lines 45-60, Figure 3, element 56, and Column 7, lines 59-63). Reber also discloses recording context information including a time of year during which data is recorded by the reader (See Reber, Column 14, lines 60-67, Column 15, lines 1-8, and Column 16, lines 29-35). Reber also discloses recording position information, such as the location of machine-readable data in relation to the substrate (i.e. the location within the header or footer of the page)(See Reber, Column 15, lines 52-62, Column 16, lines 29-36, Figure 14, Column 14, lines 60-67, and Column 15, lines 1-2).

Reber also discloses identifying document content within the reader using the recorded context information (See Reber, Column 7, lines 59-63), and transmitting from the reader the identified document content to a server (See Reber, Column 13, lines 34-50).

Horowitz '647, Horowitz '987, and Reber are analogous art because they are from the same field of endeavor of embedding data into documents.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the subtopic ID and supertopic ID arrangement of Horowitz '987 with the method of Horowitz '647. The motivation for doing so would have been to determine topic intersections of interest to the user (See Horowitz '987, Column 11, lines 52-56)

At the time of the invention it would also have been obvious to include the electronic identification tag and reader of Reber with the document enrichment system and method of Horowitz '647 and Horowitz '987. The motivation for doing so would have been to allow a user to access a document by reading the electronic identification tag rather than typing in an address, thereby making the addressing format and the address itself transparent to the user and consequently reducing the complexity of navigating a collection of documents (See Reber, Column 3, lines 20-28).

Therefore it would have been obvious to combine Horowitz '987 and Reber with Horowitz '647 for the benefit of determining topic intersections of interest to the user, supporting the highlighting or annotating of a subset of data, and reducing the complexity of navigating a collection of documents to obtain the invention as specified in claims 1, 11, and 21.

As per dependent claim 3, Horowitz '647, Horowitz '987 and Reber disclose the limitations of claim 1 as described above. Horowitz '647 also discloses that the meta-document server, upon identification of the document content, associates the personality ID with the identified document content (See Horowitz '647, Figure 8, element 808), that the meta-document server recognizes, with at least a first method, an

entity in the document content (See Horowitz '647, Column 8, lines 50-61), that the meta-document server accesses, with at least a second method, a document service using the recognized entity (See Horowitz '647, Column 9, lines 28-63), that the meta-document server annotates the identified document content with output from the document service to define enriched document content (See Horowitz '647, Figure 8, element 810, and Column 10, lines 22-27), and that the meta-document server makes the enriched document content available to a set of one or more users (See Horowitz '647, Column 11, lines 39-40).

As per dependent claims 4-6 and 9, Horowitz '647, Horowitz '987, and Reber disclose the limitations of claim 1 as described above. Reber also discloses recording the digitally readable ID from an electronic tag with an electronic tag reader, where the reader includes a transmitter and a receiver (See Reber, Column 4, lines 45-55, Figure 9, Column 10, lines 62-67, and Column 11, lines 1-6). Reber also discloses recording the digitally readable ID from embedded data recorded on a hardcopy document with a scanner (See Reber, Column 4, lines 45-55). Reber also discloses that the digitally readable ID may be recorded with a mobile computing device that identifies position coordinates where data is recorded (See Reber, Column 4, lines 24-30, Column 14, lines 60-67, and Column 15, lines 1-8). Reber also discloses that the recorded context information is time information including a timestamp (See Reber, Column 14, lines 60-67, and Column 15, lines 1-8). Horowitz '647, Horowitz '987, and Reber are analogous art because they are from the same field of endeavor of embedding data into documents. At the time of the invention it would also have been obvious to include the

electronic identification tag and reader of Reber with the document enrichment system and method of Horowitz '647, Horowitz '987, and Reber. The motivation for doing so would have been to allow a user to access a document by reading the electronic identification tag rather than typing in an address, thereby making the addressing format and the address itself transparent to the user and consequently reducing the complexity of navigating a collection of documents (See Reber, Column 3, lines 20-28). Therefore it would have been obvious to combine Reber with Horowitz '647, Horowitz '987, and Reber for the benefit of determining topic intersections of interest to the user, supporting the highlighting or annotating of a subset of data, and reducing the complexity of navigating a collection of documents to obtain the invention as specified in claims 4-6 and 8-9.

Dependent claim 12 is rejected on the same basis as claim 4.

Dependent claim 13 is rejected on the same basis as claim 5.

Dependent claim 14 is rejected on the same basis as claim 6.

Dependent claim 16 is rejected on the same basis as claim 9.

Dependent claim 17 is rejected on the same basis as claim 8.

As per dependent claim 18, Horowitz '647, Horowitz '987, and Reber disclose the limitations of claim 1 as described above. Horowitz '987 also discloses providing notification that the enriched document content is available (See Horowitz '987, Figure 12, element 1210, and Column 22, lines 16-19). Horowitz '647, Horowitz '987, and Reber are analogous art because they are from the same field of endeavor of embedding data into documents. At the time of the invention it would also have been

obvious to include the notification of available enriched content of Horowitz '987 with the document enrichment system and method of Horowitz '647, Horowitz '987, and Reber. The motivation for doing so would have been to provide the enriched data to the user organized in such a way so as to provide the user with an understanding of the organization, relationships, and nature of the content in the document collection (See Horowitz '987, Column 22, lines 20-25). Therefore, it would have been obvious to combine Horowitz '987 with Horowitz '647, Horowitz '987 and Reber for the benefit of providing the enriched data to the user organized in such a way so as to provide the user with an understanding of the organization, relationships, and nature of the content in the document collection to obtain the invention as specified in claim 18.

Dependent claim 19 is rejected on the same basis as claim 3.

Dependent claim 23 is rejected on the same basis as claim 5.

Dependent claim 24 is rejected on the same basis as claim 9.

Dependent claim 25 is rejected on the same basis as claim 18.

Dependent claim 26 is rejected on the same basis as claim 4.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", and Reber (U.S. Patent 5,986,651) as applied to claim 1 above, and further in view of Keith (U.S. Publication 2002/0032672 A1).

As per dependent claim 10, Horowitz '647, Horowitz '987, and Reber disclose the limitations of claim 1 as described above. Horowitz '647, Horowitz '987, and Reber do not disclose expressly providing notification that the enriched document is available. Keith Jr discloses notifying a user regarding updated data (See Keith Jr, Pages 10-11, paragraph 0092). Keith Jr, Horowitz '647, Horowitz '987, and Reber are analogous art because they are from the same field of endeavor of processing electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the user notification of updated data of Keith Jr with the enriched document of Horowitz '647, Horowitz '987, and Reber. The motivation for doing so would have been to push information to users when desired new information is entered into the system (See Keith Jr, Page 11, paragraph 0092). Therefore, it would have been obvious to combine Keith Jr with Horowitz '647, Horowitz '987, and Reber for the benefit of pushing information to users when desired new information is entered into the system to obtain the invention as specified in claim 10.

(10) Response to Argument

B.1.a. and B.1.b.

Appellant argues that Horowitz '987 in combination with Horowitz '647 and Reber fails to teach recording context information with a reader when a personality identifier is

recorded, which context information includes (a) time information identifying when the personality identifier is recorded with the reader and (b) position information identifying where the personality identifier is recorded with the reader. The Office respectfully disagrees. Reber teaches that the “human-viewable” form information provided may include the electronic address. Reber also teaches that the information included in the header and footer may include a date and time at which the resource was visited or the hard copy output was printed (See Reber, Column 15, lines 3-8). The Office maintains that the time and date information may be reasonably interpreted to be included within the machine-readable bar code included in the header or footer section of the document. Regarding the inclusion of position information within the machine-readable bar code information, Reber clearly states that the machine-readable information includes an electronic address, such as a URL or IP (Internet Protocol) address identifying the location, or position, of the data, and may also be used to identify servers and information contained therein (See Reber, Column 3, lines 63-67, and Column 4, lines 1-7).

B.2.

Appellant argues that Horowitz '987 in combination with Horowitz '647 and Reber fails to teach identifying document content based on when and where (i) a personality identifier is recorded with the read and (ii) document content is accessed with the reader. The Office respectfully disagrees. As stated above, the Office maintains that Reber teaches that the “human-viewable” form information provided may include the

electronic address. Reber also teaches that the information included in the header and footer may include a date and time at which the resource was visited or the hard copy output was printed (See Reber, Column 15, lines 3-8). The Office maintains that the time and date information may be reasonably interpreted to be included within the machine-readable bar code included in the header or footer section of the document. Regarding the inclusion of position information within the machine-readable bar code information, Reber clearly states that the machine-readable information includes an electronic address, such as a URL or IP (Internet Protocol) address identifying the location, or position, of the data, and may also be used to identify servers and information contained therein (See Reber, Column 3, lines 63-67, and Column 4, lines 1-7). Additionally, Reber teaches providing information identifying document content, such as instructions for linking resources associated with the advertiser (See Reber, Column 16, lines 25-28, and Column 7, lines 59-63).

B.3.

Appellant argues that Horowitz '987 in combination with Horowitz '647 and Reber fails to teach recording a personality identifier with a read together with context information. Horowitz '987 discloses using a topic ID, recorded with a dynamic content organization module, which reads the content (See Horowitz '987, Column 10, lines 41-61) into a database on a computer, and therefore digitally readable, which is associated with a topic, or personality, in a database of topics, or personalities (See Horowitz '987, Column 8, lines 36-67, Column 9, lines 1-5, and Column 10, lines 36-41). Horowitz '987

also discloses a supertopic arrangement containing associated subtopics, which can be used to enrich a document based on the specific supertopic (See Horowitz '987, Column 11, lines 52-67, and Column 12, lines 1-26), and annotating entities in the identified document content related to the associated supertopic (See Horowitz '987, Column 8, lines 52-67 and Column 9, lines 1-29). Reber teaches providing information identifying document content, such as instructions for linking resources associated with the advertiser (See Reber, Column 16, lines 25-28, and Column 7, lines 59-63). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

B.4.

In response to applicant's argument that Keith is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Keith Jr, Horowitz '647, Horowitz '987, and Reber are analogous art because they are from the same field of endeavor of processing electronic data.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Laurie Ries



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